REMARKS

Claims 1-26 stand in this application. Independent claims 1, 6, 11, 13, 17, 19, 21 and 25 have been amended. Reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-26 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of United States Patent Number (USPN) 6,044,415 (Futral) in view of USPN 6,650,761 (Rodriquez). Applicant respectfully traverses this rejection.

Claims 1-26 are patentably distinct over claims 1-16 of Futral in view of Rodriguez. Applicant submits that Futral has been improperly applied in supporting the double patenting rejection. Application further submits that Futral and Rodriguez fail to provide the requisite suggestion or motivation to combine references. Accordingly, removal of this rejection is respectfully requested.

Futral has been improperly applied in supporting the double patenting rejection. Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. MPEP 804, Section II.B.1. This means that the claims of Futral should be compared with the claims of the instant application in support of the double patenting rejection. Id. According to the Office Action (Paper No. 13) "the instant application claims associating a unique identifier with bits to the file name for client and server communication instead of using a

virtual address as claimed by Futral." Office Action, Page 3. Claims 1-16 of Futral, however, fail to recite any language directed to a "virtual address" as the term is used in the Office Action. In fact, claims 1-16 of Futral fail to recite any language related to a file name or an identifier for a file name as recited in claims 1-26 of the instant application. Consequently, claims 1-16 of Futral have been improperly used in an attempt to support the double patenting rejection.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. The analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection. MPEP, Section II.B.1. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Futral and Rodriguez fail to provide the requisite suggestion or motivation to combine references. Since claims 1-16 of Futral fail to disclose any language directed to a file name or an identifier for a file name, it is clear that Futral does not provide the requisite suggestion or motivation to combine Futral with Rodriguez. Rodriguez is directed to steganographically encoding a page with a plural-bit binary number, which

can be used later to retrieve an electronic copy of the page by scanning the page. Rodriguez, Col. 3: Line 55 to Col. 4: Line 9. This is completely unrelated and non-analogous art with respect to Futral. Rodriguez therefore fails to provide the requisite suggestion or motivation as well.

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,442,548 (Balabine) in view of Rodriguez. Applicant respectfully requests reconsideration and removal of this rejection.

Claims 1-26 define over Balabine and Rodriguez. As correctly noted in the Office Action, "Balabine did not specifically disclose that the unique identifier represents the file name with fewer bits than the file name." Office Action, Page 5. The Office Action further states that this missing element is disclosed by Rodriguez. Applicant respectfully disagrees since Balabine and Rodriguez both fail to disclose a client associating an identifier with a file name as recited in the claims. To further clarify this distinction, however, the independent claims have been amended to recite language directed to a client generating an identifier for a file in response to a file request. Support for the amendments may be found in the Specification at Page 14: Line 16 to Page 15: Line 7, for example. The IXFS 300 includes a Basic Extension Module (BEM) that provides a one-to-one mapping of a file in a file system into a collection of database objects. The BEM "allows users to quickly and transparently move their data from a file system" into a database system. Balabine, Col. 7: Lines 5-11. In other words, the BEM is designed to modify existing file systems in an attempt to integrate them with IXFS 300. IXFS 300 in general, and the BEM in particular, fail to generate an identifier for a file in

response to a file request, as recited in claims 1-26. Similarly, Rodriguez also fails to disclose this element.

For at least the reasons given above, claims 1-26 represent patentable subject matter over Balabine and Rodriguez, whether taken alone or in combination. Accordingly, removal of this rejection for claims 1-26 is respectfully requested.

Claims 3, 6-8, 10 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Balabine in view of Rodriguez and further in view of USPN 5,619,690 (Matsumani). Further, claim 24 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Balabine in view of Rodriguez, Matsumani and Applicant Admitted Prior Art (AAPA). Applicant respectfully requests reconsideration and withdrawal of these rejections.

Claims 3, 6-8, 10, 15 and 24 define over Balabine, Rodriguez, Matsumani and AAPA. Claims 3, 6-8, 10, 15 and 24 each recite the same elements as discussed with reference to Balabine and Rodriguez. The missing elements are not disclosed by Matsumani and AAPA. Therefore, the combination of Balabine, Rodriguez, Matsumani and AAPA still fails to disclose all the elements of claims 3, 6-8, 10, 15 and 24. Applicant respectfully requests withdrawal of these rejections.

For at least the above reasons, Applicant submits that claims 1-26 recite novel features not shown by the cited documents. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited documents. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited documents.

It is believed that claims 1-26 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

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Under 37 CFR 1.34(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: 5-03-04.

Deborah Higham 5-03-2004
Date

Dated: 5/3/04

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